PATENT
Customer No. 63,432
Attorney Docket No. 09138.0069-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Doug SWEET et al.	)	Group Art Unit: 4112
	)	
Application No.: 10/538,964	)	Examiner: D. Henkel
	)	
Filed: June 14, 2005	)	Confirmation No.: 5627
	)	
For: METHOD AND APPARATUS FOR AUTOMATIC STAINING OF TISSUE SAMPLES	)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement mailed July 21, 2008, the period for response to which extends to August 21, 2008, the Examiner required restriction under 35 U.S.C. § 121 between:

Group I: claims 1-5, 8, 9, 10-20, and 30-34, allegedly drawn to an automatic staining apparatus;

Group II: claims 6 and 21-24, allegedly drawn to a method of identifying a property in an automatic staining apparatus; and

Group III: claims 7 and 25-29, allegedly drawn to a method of staining samples in an automatic staining apparatus.

Applicants provisionally elect to prosecute Group I, claims 1-5, 8, 9, 10-20, and 30-34, **with traverse**.

First, the Examiner has not properly applied the standard of unity of invention that governs this application. This application is a national stage filing of a PCT case under 35 U.S.C. § 371. As such, all claims of the application must be examined together as long as there is "unity of invention" as defined in Patent Cooperation Treaty Rule 13. U.S. national law must follow this standard, and restriction practice under 35 U.S.C. § 121 may not impose more stringent requirements. 35 U.S.C. § 372. As further evidence that the present claims possess unity of invention, Applicants note that no rejection for lack of unity of invention was made in the international phase of this application.

Second, the Examiner asserts that,

> [t]he inventions listed as Groups I-III do not relate to a single general inventive concept . . . because they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is the automatic staining apparatus. This element cannot be a special technical feature . . . because the element is shown in the prior art. US Patent 5839091 teaches a method and apparatus for automatic tissue staining substantially as claimed in Group I . . .

Applicants respectfully disagree.

Under 37 C.F.R. § 1.475, which governs national stage applications, Groups I-III are one unitary invention. 37 C.F.R. § 1.475 states that:

> (a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a

contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(Emphasis added.)

Accordingly, because the invention identified in Group I is an apparatus and Groups II and III are a process of using the apparatus of Group I, these groups of inventions have unity of invention and should be prosecuted in the same application. In addition, the unity of invention requirement is also fulfilled because Groups I-III share a special technical feature that defines a contribution over the cited prior art, U.S. Patent No. 5,839,091. Specifically, independent claims 1, 8-10, 17, and 30 recite, "a control element to which said robotic element is responsive," and similarly, independent claims 6, 7, 21, and 25 recite, "feeding said image data to a control element to which said robotic element is responsive." Thus, for at least these reasons, Applicants respectfully

ask the Examiner to withdraw the restriction requirement and to allow prosecution of Groups I-III in this application.

Moreover, Applicants disagree that the prior art reference cited by the Examiner, U.S. Patent No. 5,839,091, discloses or suggests at least an automatic staining apparatus comprising "an image-capture 2-D optical sensor configured to two dimensionally image at least one element in said automatic staining apparatus." Similarly, U.S. Patent No. 5,839,091 fails to teach or suggest a method of identifying at least one property in an automatic staining apparatus comprising the step of "optically sensing a two dimensional image of at least one element in said automatic staining apparatus," and a method of staining samples in an automatic staining apparatus comprising the step of "providing an optical sensor responsive to [a] robotic element and adapted to sense a two dimensional image of at least one element in said automatic staining apparatus."

Accordingly, for at least the reasons discussed above, Applicants respectfully request that the Examiner withdraw the restriction requirement and allow Applicants to prosecute Groups I-III, including claims 1-34, in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 21, 2008

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